UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,218	01/24/2001	Lawrence W. Matusek	263-2294	2323

7590 07/29/2004	**EXAMINER**
NIXON & VANDERHYE P.C. 8th Floor 1100 North Glebe Road Arlington, VA 22201	COLON, CATHERINE M

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/768,218	MATUSEK ET AL.
	Examiner	**Art Unit**	
	C. Michelle Colon	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 January 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>6/7/01</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   The following is a Non-Final Office Action in response to the communication

received on January 24, 2001. Claims 1-9 are now pending in this application.

Information Disclosure Statement

2.   The examiner has reviewed the patents and publications supplied in the

Information Disclosure Statement (IDS) provided on June 7, 2001.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

As per the first prong of the test, for a claimed invention to be statutory, the

claimed invention must be within the technological arts. Mere ideas in the abstract (i.e.,

abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or

advance the technological arts fail to promote the "progress of science and the useful

arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found

to be non-statutory subject matter. For a process claim to be satisfactory, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the steps of method claims 1, 2 and 4-8 merely recite developing product orders by configuring products; however, the steps do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in person or by use of a pencil and paper or without the need of a computer or other technology.

As per the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention utilizes customer interaction to configure products (i.e., concrete) to develop product orders (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1, 2 and 4-8 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Geller et al. (U.S. 5,844,554).

As per claim 1, Geller et al. discloses a method of developing product orders comprising:

developing product variation configuration information through customer interaction outside of a conventional enterprise resource planning application (col. 8, lines 57-67; col. 12, lines 28-31 and 40-46; The system allows a salesperson to create product configuration information through interaction with a customer.);

storing said product variation configuration information in at least one table (col. 11, lines 28-34; col. 12, lines 57-63; The system utilizes database tables to store product data.);

importing the table into the conventional enterprise resource planning application (col. 19, lines 35-62; The system imports data from external tables to conduct product configuration.); and

performing product order related processing with the conventional enterprise resource planning application in response to said imported table (col. 19, lines 35-53; col. 25, line 64-col. 26, line 5; The system performs product ordering in response to database queries.).

As per claim 2, Geller et al. discloses the method of claim 1 wherein the developing step includes allowing the customer to interact with a web-based application (col. 8, lines 12-17; Figure 2; The application is accessible via the Internet.).

As per claim 3, Geller et al. discloses the method of claim 1 wherein the developing step includes allowing the customer to interact with a computer over the Internet (col. 8, lines 12-17; Figure 2; The application is accessible via the Internet).

As per claim 4, Geller et al. discloses the method of claim 1 wherein the developing step includes providing a multi-level product configuration function, and wherein the conventional enterprise resource planning application provides a native variant configurator that provides only single single product configuration (col. 24, lines 41-47; col. 25, line 64-col. 26, line 15; col. 26, lines 38-45; The system allows for multiple constraints in a product configuration.).

As per claim 5, Geller et al. discloses the method of claim 1 wherein the at least one table comprises at least one configuration table and at least one control table (col. 8, lines 18-26; col. 12, lines 21-39; Figures 2 and 3; The system utilizes a local database as well as an external ERP database.).

As per claim 6, Geller et al. discloses the method of claim 1 wherein the conventional enterprise resource planning application includes a variant configurator, a router, a bill of materials exploder, a costing function, and a material master (col. 9, lines 1-28; Figure 2).

As per claim 7, Geller et al. discloses the method of claim 1 wherein the developing step comprises developing a table in a format that is directly compatible with the conventional enterprise resource planning application (col. 8, lines 18-26; col. 12, lines 21-39; Figures 2 and 3; The system discloses a local database and an ERP database that interact with each other in order to perform product configuration, thus the databases are compatible.).

As per claim 8, Geller et al. discloses a method of developing customized product information comprising:

(a) providing an enterprise resource planning application including a native variant configuator having user interaction capabilities (col. 8, lines 18-67; col. 12, lines 21-39; Figures 2 and 3; The system discloses an ERP application including a product configurator with a user interface.);

(b) facilitating interaction between a customer and a further, non-native variant configuator to develop at least one configuration table (col. 8, lines 51-67; col. 12, lines 28-31 and 40-46; The system allows a salesperson to create product configuration information through interaction with a customer.); and

(c) importing the configuration table into the enterprise resource planning application such that product configuration information used by the enterprise resource planning application is developed using the non-native variant configurator rather than the native valiant configuator (col. 19, lines 35-62; The system imports data from external tables to conduct product configuration.).

As per claim 9, Geller et al. discloses a system for developing product information comprising:

an enterprise resource planning application (col. 8, lines 18-67; col. 12, lines 21-39; Figures 2 and 3; The system discloses an ERP application including a product configurator with a user interface.);

a front end interface external to the enterprise resource planning application, the external front end interface being accessible via a network and developing at least one custom table (col. 8, lines 51-67; col. 12, lines 28-31 and 40-46; The system allows a

salesperson to create product configuration information through interaction with a customer.); and

an importer that reads data from the custom table and imports said data into the enterprise resource planning application for further processing thereby (col. 19, lines 35-62; The system imports data from external tables to conduct product configuration.).

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Stauber et al. (U.S. 6,574,635) discusses application instantiation based on attributes;

- Cherneff et al. (U.S. 6,233,493) discusses a system and method for product development.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306   [Official Communications; including After Final communications labeled "Box AF"]

703-746-7202   [For status inquiries, draft communication, labeled "Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA 7th floor receptionist.

cmc
July 23, 2004

ROMAIN JEANTY
PRIMARY EXAMINER
Art Unit 3623